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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/839,158 | 04/23/2001 | Hirokazu Kawamoto | 35.G2785 | 1598 |

5514 7590 12/29/2005

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NEW YORK, NY 10112

EXAMINER

RAHIMI, IRAJ A

| | |
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| ART UNIT | PAPER NUMBER |
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2622

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 09/839,158 | Applicant(s) KAWAMOTO ET AL. | |
| | Examiner (Iraj) Alan Rahimi | Art Unit 2622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 Septemebr 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-46,48-52,54,61-64 and 66-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-46,48-52,54,61-64 and 66-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/1/05</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
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DETAILED ACTION

Response to Amendment

1. In papers filed on September 27, 2005 applicant canceled claims 47, 53, 55-60 and 65; amended claims 43, 45, 49, 51, 61-64 and 66 as well as adding new claims 67-72.

Changes to the specification were reviewed and did not introduce new matter.

Regarding claims 61-66 rejected under 101, although applicant's amendment attempted to correct the language to overcome the rejection, claims still lack the necessary verbiage. Claims for control program should also state that control program is stored on a computer readable medium.

Response to Arguments

2. Applicant's arguments with respect to restricted claims have been considered but are not persuasive. Applicant's arguments in regard to 102 rejection have been considered but are moot in view of the new ground(s) of rejection. US Patent 6,456,391 (Miyamoto) was made of record since it was omitted in the last office action.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 61-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Claims 61-66 drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized.”

Claims 61-66, while defining a program do not define program stored on a “computer-readable medium” and is thus non-statutory for that reasons. A storage medium and program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on “computer-readable medium” in order to make the claim statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 43-46, 48, 49-52, 54, 61-64, 66-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwadata Masahiro (Japanese patent 10-322487).

Regarding claim 43, Masahiro discloses an information processing apparatus for producing print data to be printed by a printing apparatus, comprising:

setting means capable of setting a plurality of output formats for one piece of data to be printed;

producing means for producing a print job comprising a group of job commands and the data to be printed in accordance with said setting means, wherein the group of job commands includes a command for the plurality of output formats; and

execution control means for controlling execution such that printing for the plurality of output formats is executed in accordance with the print job produced by said producing means (paragraphs 5, 6 and 83).

Regarding claim 44, Masahiro discloses an information processing apparatus according to Claim 43, wherein said setting means is capable of setting a combination of predetermined output formats (paragraph 5).

Regarding claim 45, Masahiro discloses an information processing apparatus according to Claim 44, wherein said the combination of predetermined output formats includes a first output format in which one page is output on one sheet and a second output format in which a plurality of pages are output on one sheet (paragraphs 62-63).

Regarding claim 46, Masahiro discloses an information processing apparatus according to Claim 43, wherein said setting means is capable of setting an arbitrary combination of output formats (paragraphs 68-70 and 83).

Regarding claim 48, Masahiro discloses an information processing apparatus according to Claim 43, wherein said execution control means transmits the print job produced by said producing means to the printing apparatus (paragraphs 19-20).

Regarding claims 49 and 61, arguments analogous to those presented for claim 43, are presented.

Regarding claims 50 and 62, arguments analogous to those presented for claim 44, are presented.

Regarding claims 51 and 63, arguments analogous to those presented for claim 45, are presented.

Regarding claims 52 and 64, arguments analogous to those presented for claim 46, are presented.

Regarding claims 54 and 66, arguments analogous to those presented for claim 48, are presented.

Regarding claim 67, Masahiro discloses an information processing apparatus according to Claim 43, wherein the print job is a single job, and said execution control means comprises converting means for converting the data to be printed into print data corresponding to the plurality of output formats more than once in accordance with the group of job commands in the print job so as to execute printing (paragraphs 64-66).

Regarding claim 68, Masahiro discloses an information processing apparatus according to Claim 43, wherein said producing means adds a command to specify the plurality of output formats into the group of job commands in a single job, when the plurality of output formats is set by said setting means (paragraph 64-66).

Regarding claims 69-72, arguments analogous to those presented for claim 67 and 68, are presented.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Iraj) Alan Rahimi whose telephone number is 571-272-7411. The examiner can normally be reached on Mon.-Fri. 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.


Alan Rahimi
December 14, 2005


TWYLER LAMB
PRIMARY EXAMINER